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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,270	06/23/2003	H. Dale Krog	8005-A-1	9111

7590 07/15/2005

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EXAMINER
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KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,270

Applicant(s)

KROG, H. DALE

Examiner

Christopher M. Keehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/23/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to mixtures and methods of preparing same, classified in class 523, subclass 122, 218 and 219.
- II. Claims 19-23, drawn to "systems" interpreted to mean coated stucco, classified in class 428, subclass 447 and 448.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are of differing scope such that Group II encompasses at least three layers including stucco, sealant, and topcoat.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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During a telephone conversation between Examiner Matthew A. Thexton and Jordan M. Meschkow at 602-274-6996 on 2005 July 6 a provisional election was made without traverse to prosecute the invention of Group II, claims 19-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-18 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: in claim 23, applicant has claimed a combination of an aqueous copolymer emulsion, an aqueous styrene acrylic copolymer emulsion, and a polysiloxane emulsion. In the specification, applicant only refers to these as being present in composition in the alternative.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is a period after the last word in the fourth line from the bottom. It is not clear what is being claimed as the resin binder.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Perlman et al. (6,033,736). Perlman et al. disclose a coating for stucco comprising a sealant coating of waterproof and breathable sealant (col.2, lines 24-30) over the stucco (col.3, lines 58-67), and a water-resistant acrylic paint applied over the sealant (col.7, lines 61-64).

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Maekawa (5,548,018). Maekawa discloses a coating for cement comprising a sealant coating of waterproof sealant (col.1, lines 43-47) over cement, and a water-resistant acrylic paint applied over the sealant (col.8, lines 48-60). Although Maekawa discloses using the composition of Maekawa on concrete, as concrete is a main constituent of stucco, there does not appear to be a reason why the same reasoning applied to stucco cannot be applied to concrete.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (6,033,736) in view of Patel (5,356,716). Perlman et al., as applied above, are as set forth and incorporated herein. Perlman et al. do not appear to specifically disclose a preconditioner layer as claimed. However, Perlman et al. do disclose using their composition as a primer or an overcoating layer (col.8, lines 47-51). Patel discloses a coating composition for coating porous surfaces such as concrete and masonry, comprising an acrylic polymer (col.3, lines 29-31) and a water-repellent silicate solution of aqueous sodium methyl silicate solution (col.3, lines 16-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the coating composition of Patel in the system of Perlman et al. because Patel teaches that using the claimed sealant composition on porous surfaces produces improved water-repellency, resulting in a higher quality product. Further, a second coating, as claimed by applicant, which the sealant layer of claim 19 meets, appears to be nothing more than the coating repetition of the first layer. The repetition of steps to provide the same results is within the skill of one having ordinary skill in the art. The concept of duplication is not patentable. *St. Regis Paper Co. v. Bemis Co. Inc.*, 193 USPQ 8, 11 (7th Cir. 1977). While this decision relates to the duplication of parts,

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there is no reason why such duplication cannot be extended to a process step. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a second layer in the system of Perlman et al. due to incomplete coverage of the first layer of as an overcoat layer, resulting in a more coherent and complete layer.

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maekawa (5,548,018). Maekawa, as applied above, is as set forth and incorporated herein. Maekawa does not appear to specifically disclose a preconditioning layer on the stucco before application of the sealant. Maekawa does disclose a primer layer of acrylic and water-repellent silicate configured to bond with the concrete (Table 1 and col.8, lines 48-60). Further, a second coating, as claimed by applicant, which the sealant layer of claim 19 meets, appears to be nothing more than the coating repetition of the first layer. The repetition of steps to provide the same results is within the skill of one having ordinary skill in the art. The concept of duplication is not patentable. *St. Regis Paper Co. v. Bemis Co. Inc.*, 193 USPQ 8, 11 (7th Cir. 1977). While this decision relates to the duplication of parts, there is no reason why such duplication cannot be extended to a process step. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a second layer of the composition of Maekawa due to incomplete coverage of the first layer, as an overcoat layer, resulting in a more coherent and complete layer.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (571) 272-1087. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Keehan

July 11, 2005

  
DAVID J. BUTTNER  
PRIMARY EXAMINER

